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24131	7590	07/28/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			EVANISKO, LESLIE J	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/833,349
Filing Date: April 12, 2001
Appellant(s): GOTTSCHALT ET AL.

Werner H. Stemer
For Appellant

EXAMINER'S ANSWER

MAILED

JUL 28 2004

GROUP 2800

This is in response to the appeal brief filed May 24, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 5 and 7-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,947,028	MONTGOMERY et al.	09-1999
4,116,594	LEANNA et al.	09-1978

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any

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inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. (US 5,947,028) in view of Leanna et al. (US 4,116,594). Montgomery et al. teach an imaging assembly comprising a printing plate and an imaging machine for setting an image on the printing plate, the printing plate being formed of a magnetically attractable material (i.e., steel), and the imaging machine including a magnetic cylinder for magnetically holding the printing plate firmly during setting of an image thereon are well known in the art. See column 1, lines 13-24 in particular. Although Montgomery et al. is silent with respect to the particular details of the magnetic drum and whether the magnetic material in the cylinder includes one

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of a permanent magnet and electromagnet, the use of a magnetic drum **14**, **14'**, **14''** having a plurality of permanent magnets along the surface for holding a printing/embossing plate **16**, **16'**, **16''** comprised of a magnetic material is well known in the art, as exemplified by Leanna et al. in column 5, lines 1-7 and Figures 3 and 15 in particular. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the cylinder of Montgomery et al. with at least one permanent magnet as taught by Leanna et al. to provide a plate that is to be imaged to be releasably fastened along the entire circumference of the drum.

Furthermore, although Montgomery et al. is silent with respect to the particular details of the magnetic drum and whether the drum includes a register system for aligning the printing plate with U-shaped register cut-outs, note that Leanna et al. teach a magnetic printing/embossing drum for holding a magnetic plate including a plurality of register pins **57''** for cooperating with U-shaped cut-outs **56''** in the plate **16''**, as described in column 6, lines 49-53 in particular. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the cylinder of Montgomery et al. with a register system as taught by Leanna et al. to aid in positioning or registering the plate on the cylinder.

With respect to claim 7, note Montgomery et al. teach the use of clamps (both magnetic and mechanical) in combination with steel plates on magnetic drums in column 1, lines 22-24.

With respect to claim 8, note that Leanna et al. teaches a cylinder using magnets that are permanent magnets, as set forth in column 5, lines 1-7.

With respect to claims 9-11, to the extent that applicant has recited any particular structure of the various imaging machines recited, note that Montgomery et al. teach an imaging machine which can broadly be considered to be any one of a “plate-exposing”, “plate-developing”, or “plate-engraving” machine. See column 1, lines 13-24 in particular.

(11) Response to Argument

Applicant's arguments filed May 24, 2004 have been fully considered but they are not persuasive of any error in the above rejection.

A. TYPOGRAPHICAL ERROR

First, in response to applicant's comment regarding the reference to Welch, Jr. et al. in the rejection, the applicant is correct in assuming that the reference to Welch, Jr. et al. in the rejection dated November 21, 2003 was a typographical error and the 35 USC 103 rejection is based upon Montgomery et al. (hereafter referred to as Montgomery) in view of Leanna et al (hereafter referred to as Leanna). In an effort to avoid any further confusion, the above 35 USC 103 rejection has been corrected to delete the erroneous reference to Welch, Jr. et al.

B. NON-ANALAGOUS ART

Applicant argues that there is no motivation in Montgomery to incorporate the feature of Leanna because the teachings of Leanna and Montgomery are non-analogous, since Montgomery is drawn to a printing arrangement while Leanna is drawn to an embossing arrangement.

In response to applicant's argument that embossing is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is the Examiner's position that embossing and printing are such closely related arts as to be considered analogous. In particular, embossing is in the field of printing because both printing and embossing broadly result in providing indicia or designs on a substrate. In fact, the Examiner points out that embossing is actually a specific form of printing that results in raised indicia or designs on a substrate. It is noted that the term "print" is defined by Merriam Webster's Collegiate Dictionary, 10th Edition, as "to impress something in or on" or "to stamp (as a mark) in or on something. Printing and embossing being in the same field of endeavor (and thereby, analogous arts) is further evidenced by the fact that printing and embossing are classified in the same class (101) of the U.S. patent classification system and that printing (class 101) is broadly defined in the

classification definitions as “means not otherwise provided for adapted to produce characters or designs on surfaces by impression of types or dies or by applying a coating material thereto through openings of pervious portions of a pattern sheet, as in stenciling, or by impression from planographic or intaglio surfaces.” It is further noted that this class definition includes dies to emboss, burn, perforate, as well as those intended to apply ink.

However, in the event one of ordinary skill in the art considers embossing to be in a different field from applicant’s endeavor (i.e., printing), the attachment of magnetic embossing plates to embossing cylinders is reasonably pertinent to the problems of attaching magnetic printing plates to printing cylinders.

Therefore, it is the Examiner’s position that printing and embossing are closely related and analogous arts and that embossing is, in actuality, a specific form of printing.

C. HINDSIGHT REASONING

Applicant also argues that the combination of Montgomery and Leanna is based purely on hindsight in view of appellant’s disclosure because Montgomery teaches a printing process while Leanna is directed to an embossing process and the two processes are completely different and in nature and different equipment is required for each process. Applicant further points to language in Leanna that states that “printing and embossing differ

both as regards to equipment employed and the nature of the process” provided in column 2, lines 5-8.

Again, the Examiner disagrees with this argument. Firstly, it is the Examiner’s position that printing and embossing, though different processes as pointed out in the language of Leanna, are closely related and analogous arts and that embossing is a specific type of printing, as set forth in the above comments. Therefore, the embossing plate of Leanna can be considered to be a “printing plate” as broadly recited. Regardless, in the event one of ordinary skill in the art would consider embossing and printing to be such drastically different processes as applicant contends, the Examiner points out that she is particularly relying upon Montgomery to show that the general relationship of a magnetically attractable printing plate being held on a magnetic drum in an imaging assembly is well known in the art. Leanna is then relied upon to show that it is well known in the art to have the specific magnetic drum arrangement (i.e., at least one permanent or electromagnet) and register system for positioning and holding a magnetically attractable plate on a magnetic cylinder. Therefore, the fact that Leanna is not a “printing plate” (as applicant argues) is of no significance since Montgomery teach a printing plate as recited. It is the Examiner’s position that it would have been obvious to one of ordinary skill in the art to provide the specific magnetic drum/plate arrangement as taught by Leanna in the device of Montgomery to provide the well recognized advantages of that arrangement--i.e., to provide an easily removable printing plate on an

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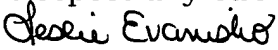
imaging drum, to provide a plate that is secured to the drum without having any interruptions in the imageable/print surface, etc. Additionally, one of ordinary skill in the art would also recognize that the use of a registration system such as that taught by Leanna in the assembly of Montgomery insures proper alignment of the print/embossing surfaces on the plate.

Further, applicant argues that the Examiner has not provided the reason why one of ordinary skill in the art would have been led to modify Montgomery or add the features of Leanna to Montgomery to arrive at the claimed method of using a printing plate according to the present invention and therefore believe the combination is based on hindsight judgement. Applicant also argues that the Examiner's statements and conclusions are arbitrary without any proper support in the cited prior art and are pure conjecture and wishful thinking. Again, the Examiner disagrees with these arguments. Leanna sets forth several reasons why it is important to use a magnetic cylinder/plate arrangement to fasten a plate on a cylinder, for example, in column 2, lines 56 through column 3, line 2. Furthermore, although Leanna does not specifically set forth the advantages of using a register system for mounting the plate on the drum, the advantages of a register system--such as proper alignment and positioning of the printing surface--are well recognized in the art. Therefore, one of ordinary skill in the art would recognize the desire to provide the particular magnetic cylinder/plate arrangement and register device as taught

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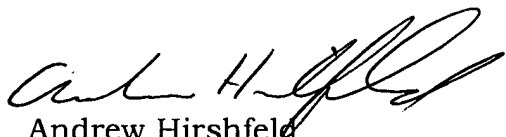
by Leanna in the device of Montgomery to provide proper positioning and mounting of the plate to be imaged on the imaging cylinder.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
July 20, 2004

Conferees


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